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APPLICATION NO.	F	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO	
09/945,325		08/31/2001	Everett C. Pesci	UIZ-068CP	1369	
959	7590	02/18/2004		EXAMINER		
		FIELD, LLP.	HUANG, EVELYN MEI			
28 STATE BOSTON,)9		ART UNIT PAPER NUMBER 1625		
,						

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)						
Advisory Action	09/945,325	PESCI ET AL.						
Advisory Action	Examiner	Art Unit						
	Evelyn Huang	1625						
The MAILING DATE of this communication appears on the cover sheet with the correspondence address								
THE REPLY FILED FAILS TO PLACE THIS APPI Therefore, further action by the applicant is required to average final rejection under 37 CFR 1.113 may only be either: (1) condition for allowance; (2) a timely filed Notice of Appeal Examination (RCE) in compliance with 37 CFR 1.114.) a timely filed amendment which	ation. A proper repl n places the applica	ition in					
PERIOD FOR RE	PLY [check either a) or b)]							
a) The period for reply expiresmonths from the mailing b) The period for reply expires on: (1) the mailing date of this A no event, however, will the statutory period for reply expire to ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS 706.07(f). Extensions of time may be obtained under 37 CFR 1.136(a). The fee have been filed is the date for purposes of determining the period of fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of 1 (2) as set forth in (b) above, if checked. Any reply received by the Office timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.17(a) is calculated from: (1) the expiration date of 1 (2) as set forth in (b) above, if checked. Any reply received by the Office timely filed, may reduce any earned patent term adjustment.	Advisory Action, or (2) the date set forth ater than SIX MONTHS from the mailing FILED WITHIN TWO MONTHS OF THE date on which the petition under 37 CFI of extension and the corresponding amount the shortened statutory period for reply the later than three months after the mail	g date of the final rejecting FINAL REJECTION. R 1.136(a) and the approperture of the fee. The appropriginally set in the final	on. See MPEP opriate extension ropriate extension Office action; or					
1. A Notice of Appeal was filed on Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.								
2. The proposed amendment(s) will not be entered be	ecause:							
(a) they raise new issues that would require further	er consideration and/or search (s	see NOTE below);	,					
(b) they raise the issue of new matter (see Note b	elow);							
(c) they are not deemed to place the application ir issues for appeal; and/or	n better form for appeal by mate	rially reducing or sir	nplifying the					
(d) they present additional claims without cancelingNOTE:	ng a corresponding number of fi	nally rejected claim	S.					
3. Applicant's reply has overcome the following reject	ion(s): see attachment to adviso	ory action.						
4. Newly proposed or amended claim(s) would canceling the non-allowable claim(s).	be allowable if submitted in a se	eparate, timely filed	amendment					
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for application in condition for allowance because: see		dered but does NO	T place the					
6. The affidavit or exhibit will NOT be considered becaraised by the Examiner in the final rejection.	ause it is not directed SOLELY to	o issues which were	e newly					
7. For purposes of Appeal, the proposed amendment explanation of how the new or amended claims we			and an					
The status of the claim(s) is (or will be) as follows:								
Claim(s) allowed: Claim(s) objected to: Claim(s) rejected: <u>1,3-13,15-42 and 46-48</u> . Claim(s) withdrawn from consideration:								
8. The drawing correction filed on is a) appr	oved or b) disapproved by the	ne Examiner.						
9. Note the attached Information Disclosure Statemer	nt(s)(PTO-1449) Paper No(s)							
10. Other:								
		Evelyn Huang Primary Examiner Art Unit: 1625	T					

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Attachment to Advisory Action

1. The objection to claims 20-34 under 37 CFR 1.75 as being a substantial duplicate of claims 1 and 19 is maintained for reasons of record, since the use recited in claims 20-28 does not further limit the compound of claim 1 or 19. Applicant argues that not all compounds of formula I are autoinducer molecules, the scope of claims 20-34 therefore is not the same as claims 1 or 19. However, such a concept has not been described in the specification, rather the contrary has been described (page 8 of the specification).

2. The scope rejection under 35 U.S.C. 112, first paragraph is maintained for reasons of record.

Applicant repeatedly contends that Bycroft makes absolutely no reference to quinolone compounds or quinolone compounds as autoinducers. Indeed, Bycroft's homoserine lactone compounds are cited to illustrate the unpredictability of the art because at the time of the invention, quionlone compounds as autoinducers have not been described.

Applicant argues that the two compounds described on page 24 of the specification is not within the scope of the claims and the compounds in the compound claims are not necessarily autoinducers. However, such a concept has not been described in the specification, rather the contrary has been disclosed (page 8 of the specification).

Applicant maintains that the examiner has arrived at the conclusion based on only one of the evaluation factors, while ignoring one or more of the others. On the contrary, it is in view of the state of the art, the high degree of unpredictability of the art, the absence of specific working examples, together with the fact that the scope of the claims does not commensurate with that of the objective enablement, that lead to the conclusion that sufficient teaching and guidance have not been provided in the specification to enable one of ordinary skill in the art to practice all the invention as claimed without undue experimentation.

3. The rejection for Claims 1, 4, 10-14, 19-28, 32-42, 46-48 under 35 U.S.C. 102(b) as being anticipated by Takeda (Hakko Kogaku Zasshi (1959), 37, 59-63, abstract) is maintained for reasons of record.

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Applicant repeatedly alleges that Takeda's compound is not 2-heptyl-3-hydroxy-4-quinolone because it has a different melting point and different degree of antibacterial activity than the instant. The different physical data and/or different degree of biological activity presented in the specification do not invalidate the Takada reference, especially in view of the fact that it is well known in the art that a compound of a particular structural formula may exist in different physical forms having different melting points. Furthermore, the melting point of the instant 2-heptyl-3-hydroxy-4-quinolone (PQS) has not been recited in the claims. Takeda's compound having the same structural formula as the instant therefore meets every requirement of the claims, and therefore expressly anticipates the claimed invention. Since the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See also MPEP § 716.07. Applicant has provided arguments, but not convincing facts and evidence rebutting the presumption of operability.

4. The 112 second paragraph rejection for claims 14-16 is withdrawn in view of the cancellation of claim 14 and the amendment of claims 15-16.